



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,718	04/04/2001	Yoji Furuya	36409-01100	3164
27171	7590	04/27/2006	EXAMINER	
MILBANK, TWEED, HADLEY & MCCLOY			POND, ROBERT M	
1 CHASE MANHATTAN PLAZA			ART UNIT	PAPER NUMBER
NEW YORK, NY 10005-1413			3625	

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/825,718	FURUYA, YOJI
	Examiner Robert M. Pond	Art Unit 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 February 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 49-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 49-56 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 07 February 2006 has been entered. The Applicant's submissions was in response to a non-responsive amendment communication issued against the RCE filed 17 May 2005.

Response to Amendment

The Applicant canceled all previously examined claims 1-30. Newly added claims 31-48 submitted with the RCE were canceled in response to the non-responsive communication issued on 11 August 2005. Newly added claims 49-56 were examined in this non-final office action drawing to originally elected claimed subject matter.

Response to Arguments

Applicant's arguments filed 07 February 2006 have been fully considered but they are not persuasive. Melvin was cited as a pertinent teaching demonstrating

a printer can have multiple connection means to support directly attached computers and network computers.

Please note

Examination based on Applicant's claim to 112 6th paragraph for:

- Claim 49: first connection means, second connection means, request reception means, data reception means, output means, determination means, and data request transmission means.
- Claim 50: transmission means.
- Claim 51: charge information storage means, and deletion means.
- Claim 52: data storage means, data reception means, deletion means.
- Claim 53: management means, and determination means.
- Claim 55: determination step, data request transmission means, control step, first connection means, second connection means, data reception means, request reception means, and output means.
- Claim 56: determination step, data request transmission means, control step.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 49, 50, and 53-56 are rejected under 35 USC 103(a) as being unpatentable over Chihara (Paper #5, US 6,208,428) in view of Machine Design (Paper #5, PTO-892, Item: W), further in view of Melvin (PTO-892, Item: U).

Chihara teaches a system for outputting data selected by user-side to an information processing device on a supplier-side. Chihara further teaches:

- Output device:
 - i. Output device including data request means: a printer (see at least Fig. 1 (7); Fig. 2 (16); Fig. 7 (2); col. 1, lines 9-57; col. 5, lines 52-67).
 - ii. Output device communications means: output device connects to supplier-side information processor independent of user-side information processor (see at least Fig. 7 (2); col. 11, lines 20-26).
 - iii. Output device transmission means for sending charge information: transmits charging information; charging information storage means (see at least title; Fig. 1 (76); col. 1, lines 14-57; col. 2, lines 23-36).
 - iv. Output device request reception means from information processing device; receives data: prior to transfer of data, send print control code that causes the printer to notice the total print number; higher ranking computer transmits printing commands (see at least Fig. 3 (S5, S6); col. 9, lines 20-34).

- v. Predetermined functionality: printing with charge control program as noted above.
- vi.
- Information processing device (supplier side):
 - i. Information processing device: a server computer (see at least col. 5, lines 52-67).
 - ii. Determination means: inherent in Chihara is determination means of the type of output device connected (please note: uses bi-directional communication cable connecting to higher ranked device's printer status monitor, printer setting request monitor, and printer data transmission monitor) (see at least Fig. 2 (15, 16, 17, 100); Fig. 7 (100); col. 7, lines 48-65).
 - iii. Controller for controlling transmission of data to output device: (see at least Fig. 1 (70); Fig. 2 (1); col. 1, lines 24-26).
- Information processing device (user sided): producer client computer (col. 5, lines 52-67).
- Information processing device recognized the output device: store data of the status and construction of the printer (see at least col. 5, lines 30-31, 60-61).
- Identifiers: identifies each producer; means for recognizing every producer (see at least col. 1, lines 62-63; col. 2, lines 14-15).

- Storage means: storage medium (see at least Fig. 1 (75, 76); Fig. 2 (14, 18 21, 22)).

Chihara teaches all the above as noted under the 103(a) rejection and teaches a) a prior art printer with a connection to a host computer (please note: typically a standalone computer on either user side or supplier side), b) a higher ranking device computer connected to a printer using a bi-directional communications cable (please note: a first connection means) (Fig. 2 (100)), c) a user-side computer connected to a supplier-side computer over a network (please note: a second connection means) (Fig. 7 (3, 4, 110)), d) the supplier-side computer as a higher ranking device than a printer connected to a printer with a bi-directional communications cable (please note: identical connection means as first connection means) (Fig. 7 (2, 3, 100)), and e) a user-side computer and a supplier-side computer as higher ranking devices than a printer (Fig. 7 (2, 3, 4)). Chihara, however, does not disclose the user-side computer having a first connection means to an output device. Machine Design teaches an Internet printing system that is fully integrated with standard operating systems that allows sending print jobs to printers connected to the Internet. Machine Design teaches sending print jobs to a personal printer attached to a personal computer connected to the Internet. Machine Design further teaches the user-side computer having a direct connection to the personal computer's parallel or serial port. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of Chihara to disclose a user-side

computer connected to a network to have a first connection to a printer as taught by Machine Design, in order to support local user-side printing by users.

Chihara and Machine Design teach all the above as noted under the 103(a) rejection and teach a) user-side printer having a direct connection to a user-side computer that is connected to the Internet, b) sending print jobs to printers connected to the Internet or a personal printer attached to a PC (please note examiner's interpretation: printer has it's own Internet connection), c) printers connected directly to the Internet receiving print jobs without the need for spooling on a file server, and further teach printing across the Internet avoiding the need to send large e-mail attachments which rely on the receiver having an appropriate application for printing (please note examiner's interpretation: a benefit to the user) (W: see page 1), but do not disclose a printer with a first connection means having a second connection means. Melvin teaches desktop printers containing both parallel port connections (a first connection means) and a network connection (e.g. USB) (U: see page 3). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify Chihara and Machine Design to implement a printer with a first connection means having a second connection means as taught by Melvin, in order to offer users more benefit in one printer than two printers (i.e. one printer directly attached to a computer and the other printer connected to the Internet), and thereby attract users to a single printer that supports both connections.

Pertaining to system claims 49, 50, 53, and 54

Rejection of claims 49, 50, 53, and 54 is based on the same rationale as noted above.

Pertaining to storage medium claim 56

Rejection of claim 56 is based on the same rationale as noted above.

2. **Claims 51 and 52 are rejected under 35 USC 103(a) as being unpatentable over Chihara (Paper #5, US 6,208,428), Machine Design (Paper #5, PTO-892, Item: W), and Melvin (PTO-892, Item: U), as applied to claim 49, further in view of Rager (Paper #5, US 5,363,447).**

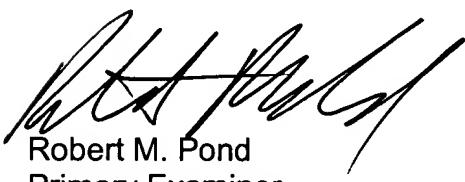
Chihara, Machine Design, and Melvin teach all the above as noted under the 103(a) rejection and teach a) storing charging information in memory, b) storing print data, and c) deleting information, but do not disclose deleting information upon detecting a power-off condition. Rager teaches erasing memory to maintain data security in the event that a device is tampered with or powered down (see at least col. 1, lines 64-67; col. 4, lines 37-49). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chihara, Machine Design, and Melvin to include power-off detection and data deletion as taught by Rager, in order to provide tamper-proof data protection of chargeable print data, and thereby attract data suppliers to the service.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Yogesh Garg can be reached on 571-272-6756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond
Primary Examiner
April 26, 2006